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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,212	01/19/1999	JEFFREY ALLEN JONES	AT9-98-567	2081

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/232,212

Applicant(s)

JONES ET AL.

Examiner

Michael Y Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Conclusion

1. Claims 21, 27, and 33 have been amended and new claims 39-41 have been added.
2. Claims 21-41 have been examined and are pending with this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The element of claims 39-40, specifically "the at least one information element presence within the information to be transmitted being unknown to a user" raises an issue of ambiguity. The examiner cannot conclude from the specification that such claimed limitation is an inventive step, but rather the shortfall of prior art that which the applicant(s) are attempting to overcome, as suggest on page 2, lines 15-16 of the specification. Also, this element of the claimed invention conflicts with the next element "wherein the message presents the at least one information element and includes...so that a user can determine whether the message should be sent".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 21-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. (US 5,815,657 A).

Independent:

As per claims 21, 27, and 33, Williams teaches a method, an apparatus, and a computer program product in a computer-readable medium for communicating over Internet (see col.9, lines 30-32) comprising: responsive to receipt of a signal to transmit information created automatically (see col.19, line 23, "internet browser implemented") by a process resident on the Internet processor over an established Internet connection (see col.15, line 66 to col.16, line 30; Fig.6; and col.19, lines 22-40), identifying at least

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one information element within the information to be transmitted (see Fig.10; Fig.21; and col.11, lines 5-10, 24-30 & 53-63); generating a message (see col.11, line 6: "browser launches" and col.13, lines 31-36: "GUI components for wallet creation"), wherein the message presents the at least one information element (see col.12, lines 35-40; col.14, line 62 – col.15, line 4; and col.21, lines 25-32) and includes a cancel control (see Fig.10, #1010; Fig.11, #1150; Fig.15, #1595; Fig.16, #1695; Fig.17, #1746) for canceling transmission (see col.2, line 66 – col.3, line 7), so that a user can determine whether the message should be sent (see abstract: "user to select"); and responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection (see Fig.13 and col.31, lines 18-20).

As per claims 39-41, Williams teaches a method, an apparatus, and a computer program product in a computer readable medium in an Internet processor, for communicating over the Internet (see col.9, lines 30-32), the method, apparatus, and computer program product comprising: instructions, responsive to receipt of a signal to transmit information created automatically (see col.19, line 23, "internet browser implemented") by a process resident on the Internet processor over an established Internet connection (see col.15, line 66 to col.16, line 30; Fig.6; and col.19, lines 22-40), for identifying at least one information element within the information to be transmitted (see Fig.10; Fig.21; and col.11, lines 5-10, 24-30 & 53-63), the at least one information element presence within the information to be transmitted being unknown to a user (inherent: uploading of data are unknown to users unless they have been initiated by the user or until the user is notified via a graphical display on the monitor); instructions

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for generating a message, wherein the message presents the at least one information element and includes a cancel control (see Fig.10, #1010; Fig.11, #1150; Fig.15, #1595; Fig.16, #1695; Fig.17, #1746) for canceling transmission (see col.2, line 66 – col.3, line 7), so that a user can determine whether the message should be sent (see abstract: “user to select”); and instructions responsive to selection of the cancel control, for canceling transmission of the information over the established Internet connection (see Fig.13 and col.31, lines 18-20).

Dependent:

As per claims 22, 28, and 34, Williams further teaches wherein the message includes a selection control for each information element disclosed in the message (see Fig.10; Fig.11; Fig.14; Fig.21; col.18, line 65 - col.19, line 3; col.22, lines 17-19; and col.31, lines 28-40).

As per claims 23, 29, and 35, Williams further teaches wherein each selection control is selected by default (see col.18, lines 16-19).

As per claims 24, 25, 30, 31, 36, and 37, Williams teach of further comprising: responsive to deselection of a selection control (see col.22, lines 32-36), blocking transmission of the information element corresponding to the selection or deselection control (see col.38, line 6-12: only what has been selected is transmitted). **Note:** what is transmitted and not transmitted resulted by selection or deselection is a matter of programming. This limitation is subjective and does not patentably distinguish the claimed invention. Williams clearly teaches of enabling the user to choose what is transmitted and what is not.

As per claims 26, 32, and 38, Williams further teaches wherein the message presents the address of the Internet server to which the information is to be transmitted (see col.13, lines 45-47: "merchant URL").

Response to Arguments

5. Applicant's arguments filed November 13, 2004, have been fully considered but they are not persuasive. Williams et al. US 5,815,657 (herein referred to as Williams) clearly teaches all the limitations of the claimed invention.

In response to remarks regarding application to be considered special, the examiner notes that part of the reason for the delay (5 years) was because this application had on October 3, 2003 gone abandoned (7 month delay from prior office action) and was revived via a petition. Nonetheless, a primary examiner has personally checked on the pendency of this application as suggested, and has agreed with the rejections set forth.

In response to the argument regarding claims 1, 27, 33, and 39-41, specifically the element "responsive to a receipt of a signal to transmit information created automatically by a process resident on the Internet processor", the referenced locations clearly teach of a web browser "implemented as a Java applet detects the selection of a payment button" (i.e. automatic). Whether the "automatically creating" was initiated by the user clicking a payment button, is irrelevant of the fact that the information to be transmitted is still created automatically by a process resident on the Internet processor

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and sent to the user (see col.16, lines 5-17 & 27-30). Furthermore, the teachings of Williams is consistent with the applicant(s) disclosed invention: "When a user with an Internet processor accesses a web page, an Internet connection is made to the Internet server of the web page and the web page document is transmitted to the Internet processor of the user where the web page document is displayed" (see page 1, lines 13-16). Clearly one of ordinary skill in the art would suggest that the "signal to transmit information created automatically" occurs at both the "Internet processor" and at the "Internet server" by a communication established there between, and clearly is a result of normal browsing action on the Internet (by the clicking of a mouse by the user). To overcome the prior art of Williams with respect to "created automatically", the applicant is suggested to amend the claim language to clearly teach one of ordinary skill in the art the distinction over the prior art and such amendment must be supported by the specification.

In response to applicant's argument regarding claims 24, 25, 30, 31, 36, and 37, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "information is ready to be transmitted at the time of the selection") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument regarding claims 26, 32, and 38, clearly the recited reference teaches of a message that presents the address of the Internet server (see also col.15, lines 62-65 and col.16, lines 14-17).

Conclusion

6. It is the duty of the patent examiner, during patent examination, that the pending claims be given their broadest reasonable interpretation consistent with the specification and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Claims 21-41 have been finally rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

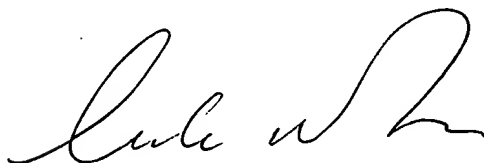
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



February 10, 2005


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER